UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,655	04/23/2001	John Yin	515-A01-001	5026

23334 7590 09/15/2004	EXAMINER
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI	NGUYEN, CUONG H

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3625	

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _01 June 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _6-13 and 19-27_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _6-13 and 19-27_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _23 April 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Status of the Claims

1.   Claims 6-13, 19-27 are pending; claims 1-5, 14-18, and

28 are cancelled by the applicants on 6/01/2004.

Claim Rejections - 35 USC § 103

*The following is a quotation of 35 U.S.C. 103(a) which forms the basis
for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
in section 102 of this title, if the differences between the subject matter sought to be patented and the prior
art are such that the subject matter as a whole would have been obvious at the time the invention was
made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall
not be negatived by the manner in which the invention was made.

2.   **Claims 6, 9-11, 13, 19, 23-24, 26 are rejected under**

35 U.S.C. 103(a) as being unpatentable over Williams (US

Pat. 6,591,272), in view of "Indigo Contrack®" article (see

IDS, http://www.indigosolutions.com/packagedapps.html).

Indigo ConTrack® - The Total Contract Management

Solution gives artisan a benefit of knowing obligations,

expiration dates, flexibility and growth, .etc. in

management (see "Indigo Contrack®, pp.1-2).

A.   As to independent claim 6: Williams discloses a method,

comprising:

a)   receiving critical items as defined by a client (see

Williams, claims 3, 6, 7) - (critical items are defined as

"metadata" - please note that it is obvious for "a contract

previously has been executed by other parties" e.g., a sub-

contract;

b)   receiving a rule based on said critical items (see Williams, claim 6); and

c)   executing said rule (see Williams, claim 6).

Williams does not disclose that critical items in a contract are represented by metadata.

However, Indigo ContracK® teaches that critical items are obligations of a party under an agreement (see Indigo Contrack®, page 1, 2nd para.).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Williams and Indigo Contrack® teachings to suggest a method for managing multiple interpretations from a single contract in a client-server environment because Indigo Contrack is the perfect software tool for determining exactly what commitments, both active and those in process; in another word, Indigo Contrack software is available to help a client takes control of a real contract.

B.   As to independent claim 19: It is directed to a computer readable medium containing programming instructions for managing multiple interpretations from a single contract in a client-server environment, claimed programming instructions to perform similar steps as claim 6 although they are expressed in different claimed languages; therefore, similar rationales and references for rejection of claim 6 are also applied based on obviousness.

C. As to dependent claim 9, 22:

The rationales and reference to reject claim 6 are incorporated.

Williams suggests a step of receiving metadata which may comprise terms, conditions, dates, and payments (see Williams, claims 3, 6, 7); it would be obvious to one of ordinary skill in the art at the time of invention to comprise exactly terms, conditions, dates, and payments because a business contract would require a disclosure of those fundamental terms.

D. As to dependent claims 10, 11, 23, 24:

The rationales and reference to reject claim 6 are incorporated.

Williams suggests a step of receiving a user login (see Williams, claims 3, 6, 7); it would have been obvious to one of ordinary skill in the art at the time of invention to recognize that "that permits access only to predetermined areas of the contract upon which only metadata in the predetermined areas of the contract is subsequently received.", or "that permits access only to predetermined areas of the contract upon which rules in the predetermined areas of the contract can be subsequently executed." are merely intends of use the received content.

E. As to dependent claims 13, 26:

The rationales and reference to reject claim 6 are incorporated.

Williams suggests of receiving a rule from a client (see Williams, claims 3, 6).

Williams does not expressly disclose that a rule is selected from a menu driven template.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Williams and Indigo software to receiving a rule from a client wherein a rule is selected from a menu driven template because receiving a rule from a client is crucial to the claimed method, it is not necessary that a rule MUST be selected from a menu driven template because it is well-known to select a predetermined rule.

3. **Claims 12, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US Pat. 6,591,272), in view of the IDS: "Indigo Contrack®" article, and further in view of Morgenstern (US Pat. 5,970,490).**

The rationales and reference to reject claim 6 are incorporated.

Williams receive a client metadata with a parsing process (see Williams, claims 3, 6, 7).

Williams does not expressly disclose about metadata is outlined/delineated by XML tags in the contract.

However, Morgenstern suggests that a metadata is outlined by XML tag (see Morgenstern, 45:65 to 46:5).

It would have been obvious to one of ordinary skill in

the art at the time of invention to combine Williams,

Morgenstern, with Indigo software to suggest about using

metadata in a contract, wherein that metadata is

outlined/delineated by XML tag in the contract for a benefit

of changeable metadata without updating each critical item

in a document.

4.   **Claims 7-8, 20-21 are rejected under 35 U.S.C. 103(a)**

as being unpatentable over Williams (US Pat. 6,591,272), in

view of the IDS: "Indigo Packaged Applications" article.

The rationales and reference to reject claim 6 are

incorporated.

Williams does not disclose about an instant

notification in his client-server environment.

However, Indigo InstantNotifier® solution was designed

to meet that limitation: "We can also send you updates via e-mail as

development progresses" (see Indigo Packaged Applications pg.1, 2nd

para.).

It is well-known that above "sending a notification"

happen after executing that Indigo software.

It would have been obvious to one of ordinary skill in

the art at the time of invention to implement Williams with

Indigo software to suggest about sending a notification to a

client after executing a rule/condition because a client

always feel comfortable with a update status of a contract.

5.   Claim 27 is rejected under 35 U.S.C. 103(a) as being

unpatentable over Williams (US Pat. 6,591,272), in view of

the IDS: "Indigo Packaged Applications" article, and further

in view of the IDS: "Indigo Contrack®" article.

This claim is directed to a method, comprising the

above analyzed steps of:

a)   presenting on a graphical user interface, critical

items/metadata of a contract which has been previously

executed by different parties;

b)   selecting critical items/metadata; sending the critical

items/metadata to another location;

c)   prompting a rule based on critical items;

d)   sending a rule to another location; and

e)   receiving a notification when a rule has been executed.

Williams does not disclose about an instant

notification in a client-server environment (limitation e).

However, Indigo InstantNotifier® solution was designed

to meet that limitation: "We can also send you updates via e-mail as

development progresses" (see Indigo Packaged Applications pg.1, 2nd

para.).

It is well-known that above "sending a notification"

happen after executing that Indigo software.

The examiner respectfully submits that it would have

been obvious to one of ordinary skill in the art at the time

of invention to recognize these claimed limitations are

obvious based on the above analysis of rejected claims 6-13; although that claimed method happens on a different portion (a server side instead of a client side) - same interactions between a client and a server take place, the client and server machines still work together to accomplish the processing of the application being used; the client portion of the application is optimized for user interaction, whereas the server portion provides a centralized, multi-user functionality.

Conclusion

6.   Claims 6-13, 19-27 are not patentable.

7.   The attached prior art are pertinent to claimed subject matter of this pending application.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

CUONG H. NGUYEN
Primary Examiner
Art Unit 3625